REMARKS

Claims 8-33, 48, 49, 51, 52 and 71-80 are pending, along with new claims 81-90. Claims 81-90 have been added in order to claim the invention from additional perspectives. Support for the added claims can be found throughout the original specification, including the claims and drawings, and in particular at pages 45-54. The new claims are all substantially similar to one or more of claims 8-33, 48, 49, 51, 52, and 71-80 and thus should not require additional searching by the Patent Office.

Section 2 of the Office Action states that applicants' arguments with respect to claim 8-33, 48-49, and 51-52 filed on *February 11*, 2002 have been considered but are moot in view of the new grounds of rejection. Applicants respectfully submit that the Patent Office meant to say *July 10,* 2002, not February 11, 2002.

Claims 8-33, 48, 49, 51, 52, and 71-80 stand rejected on new grounds. In section 4 of the Office Action, the Patent Office states that claims 8-33, 48, 49, 51, 52, and 71-80 are rejected under 35 U.S.C. § 103(a) as unpatentable over Minton (U.S. Pat. No. 6,014,643) in view of Stokes, "DTN Adds NASDAQ Level II Stock Quotes to its Real-time Service." These rejections are respectfully traversed.

Claim 8 reads as follows:

> 8. (Amended) A computer program for providing a computer interface facilitating user-to-user security trading service for users communicating over a network with a computer system, the interface comprising: (a) a computer display of orders to buy certain securities at different prices based on data transmitted over the network by at least some of the users of the service; and (b) a computer display of offers to sell the certain securities at different prices based on data transmitted over the network by at least some of the users of the service, wherein at least some displayed data is updated with data transmitted over the network by the computer system without the user requesting any updates.

Section 4 of the Office Action correctly concedes that Minton does not disclose having at least some displayed data updated with data transmitted over the network by the computer system without the user requesting any updates. Other deficiencies of Minton have

been noted in previous communications in this case, all of which are incorporated by reference herein. Stokes is the new reference cited by the Patent Office, so the discussion below is directed primarily toward Stokes.

The Patent Office states that Stokes, "in the same field of endeavor, discloses a computer program for providing trading of financial instruments." Applicants respectfully disagree. Stokes is not in the same field of endeavor, and it does not disclose a computer program for providing trading of financial instruments. Stokes discloses a subscription service that broadcasts information to a user via satellite. See the last sentence on page 1 of Stokes: "Since the DTN service is available by satellite, there are no Internet service provider charges or phone charges."

Because Stokes only discloses a satellite broadcast service, and not an interactive Internet (or other interactive computer network) service, it is not "in the same field of endeavor," and is non-analogous art. Although claim 8 does not require the network to be the Internet, it does require the network to be capable of two-way communication, since it is directed to "a computer program for providing a computer interface facilitating *user-to-user security trading service for users communicating over a network with a computer system.*" Satellite networks, as known when the Stokes reference was published and at the time of applicants' invention, were generally incapable of two-way communication, so one seeking to construct the claimed invention, which requires two-way communication, would not reasonably be expected to consult the field of satellite broadcast technology. Thus, Stokes is from a completely different field of endeavor and is non-analogous art.

Moreover, Stokes does not disclose a computer program for providing trading of financial instruments. The Stokes program only passively displays information. That information might be used by a trader of financial instruments, but the Stokes software only displays the information provided via satellite -- it does not provide any capabilities for trading financial instruments. A trader wishing to trade stocks based on the information provided by the Stokes system must use a separate system to conduct trades. Stokes only discloses a passive, one-way information-providing system (like radio), whereas the system contemplated by the claimed invention provides an active, two-way information-exchanging system (like the telephone system).

Also, partly because Stokes is non-analogous art, neither Stokes alone nor Stokes in combination with Minton is enabling. Stokes does not enable one skilled in the art of Internet technology, for example, to provide real-time stock updates over the Internet. Stokes's system broadcasts the same information to all subscribers via satellite, presumably appropriately encoded so that only subscribers can view the information. That procedure does not tell one familiar with Minton how to provide, for example, customized real-time stock updates to Internet subscribers.

Even if Stokes and Minton could somehow be combined to create the claimed invention, that combination would be improper because Stokes is non-analogous art, as discussed above, and because there is no suggestion or motivation in the prior art for such a combination. In effect, the Patent Office has improperly used each of applicants' claims as a roadmap for attempting to combine disparate references in order to piece together elements of the claim. As is well-known, this is improper.

Moreover, an attempted modification of Minton to incorporate the real-time broadcast features of Stokes would change the two-way principle of operation of Minton. Such a modification is improper. A suggested combination of references cannot require a substantial reconstruction and redesign of the elements shown in the primary reference and a change in the basic principle under which the primary reference was designed to operate. See MPEP § 2143.01.

The arguments herein regarding claim 8 also apply to overcome the rejections of the remaining claims. The claim rejections in section 4 of the Office Action are therefore believed to be overcome, and reconsideration is respectfully requested.

However, the rejections in section 4 of claims 74-76 in particular should be withdrawn for additional reasons. Claim 74, for example, requires real-time updating of the user's positions. As a practical matter, this type of data – user-specific data – cannot be updated in real-time using a broadcast method such as that disclosed in Stokes. If individual user data were broadcast via satellite to one user, it would have to be broadcast to all users. So to provide each user with user-specific data in real time, the satellite would be forced to broadcast all users' user-specific data (such as account data) all the time, and that would be

cost-prohibitive. Also, the receiving software would have to sift through a vast amount of data in order to identify, tabulate, and display a particular user's data. Indeed, such a process would be so complicated that even if a user's data were *received* in real-time, it would be unlikely to be *displayed* in real-time. This problem, among others, is what prevents Stokes from being proper prior art in this case. In particular, it causes the rejections of claims 74-76, which each require real-time updating of user-specific data, to be improper for reasons beyond those discussed above with respect to the other claims. Similar arguments apply to the rejections of claims 79-80. Broadcasts of all news items, for example, related to all securities would be impractical. For this reason, aside from those discussed above, the method of Stokes cannot be incorporated into the method of Minton in order to provide real-time updating of news items related to a security of interest. The data streamed by Stokes is necessarily generic to all users. Thus, one familiar with Minton would not look to Stokes to learn how to provide real-time updates to users of the system of Minton.

All claim rejections in section 4 of the Office Action have now been shown to be improper, and reconsideration is respectfully requested.

Section 5 of the Office Action states that claim 20 is rejected as being unpatentable over Minton and Stokes as applied to claim 19, and further in view of Tull (U.S. Pat. No. 6,092,056). This rejection is respectfully traversed.

Section 5 states that "the combination of Minton and Stokes fails to explicitly disclose displaying the performance of the securities." To the extent that the Patent Office admits that Minton and Stokes cannot be combined to anticipate claim 20, applicants agree. The Patent Office then goes on to state that Tull "discloses performance of a financial instruments 'securities.'" As best understood by applicants, the Patent Office is stating that Tull discloses displaying performance of securities on a watch list of securities, as required by claim 20. Applicants respectfully disagree. As explained in previous communications, Tull is directed to an instrument based on an underlying "basket" of stocks. The price of the instrument is reported to customers, but not the prices of the stocks.

Claim 20 is directed to "software for simultaneously displaying non-overlapping computer display of performance of the securities." Claim 20 depends from claim 16, so "the

securities" of claim 20 are the securities of claim 16 – i.e., securities on a "watch list of securities."

But the instrument described in Tull is not on a "watch list" – i.e., a list created by the user – it is a single instrument "based on an underlying basket of stocks." Nor can the stocks on which the instrument is based be found on a watch list created by a user: they are "selected to track an established capital market," and they are not selected by a user, but by the claimed system. See, for example, column 7, lines 2-66. Therefore, they are not on a watch list of any kind, especially not a watch list created by a user. Thus, Tull does not disclose displaying performance of securities on a watch list to a user, as is required by claim 20.

Moreover, the attempted combination of three disparate references by the Patent Office is another example of improper use of the applicants' disclosure as a roadmap to combine disparate references. See MPEP § 2143. Two of the three references, Stokes and Tull, are not even in the field of Internet securities trading, and thus are non-analogous art. Also, the impropriety of combining Tull with the combination of Minton and another reference has been discussed in previous communications, all of which are incorporated herein by reference. In particular, there can be no suggestion or motivation in the prior art to combine Tull with the combination of Minton and Stokes, since the combination of Minton and Stokes did not exist in the prior art.

Section 6 of the Office Action states that claim 33 is rejected under 35 U.S.C. § 103(a) as unpatentable over Minton and Stokes as applied to claim 29, further in view of Tull. Because claim 33 depends from claim 29, "the securities" of claim 33 are the securities of claim 29 – i.e., securities on a "watch list of securities." Therefore, the same arguments above that show the rejection of claim 20 to be improper also show the rejection of claim 33 to be improper.

In view of the foregoing, applicants believe that all rejections have been overcome, that all of pending claims are in condition for allowance, and respectfully request the Patent Office to pass the subject application to issue.

Applicants believe the arguments herein more than suffice to overcome the rejections in the Office Action so, in the interests of efficiency, applicants have not attempted to discuss every ground for withdrawing those rejections. Consequently, the fact that some grounds for allowing the claims may not have been discussed herein or in prior communications should not be taken as a waiver of the right to raise those grounds in the future.

No fee (other than the $110 extension fee authorized above) is believed due for filing this response. However, if a fee is due, please charge such fee to Pennie & Edmonds LLP's Deposit Account No. 16-1150.

Respectfully submitted,

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